

Application No. 10/056,336  
Amendment dated January 3, 2005  
Reply to Office Action of October 5, 2004

### REMARKS

Reconsideration of the present application is respectfully requested. Independent claims 1, 8, 12, 14, 18, and 19, and dependent claims 7, 10-11, and 16-17 have been amended. Claims 1-24 remain pending in this application. No new matter has been added.

### Claim Objections

The Office Action objects to claims 7, and 10-11 asserting that the submitted dependent claims are in improper dependent form. Claims 7, and 10-11 have been amended to more clearly indicate that they depend from the entire method of their respective base claims, rather than the steps they recite.

As amended, claims 7, and 10-11, are in proper dependent claim format. A claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. 35 U.S.C. §112 ¶4. The aforementioned claims each reference a claim previously set forth. Claims 7, and 10-11 are written in a format that defines, in dependent form, an embodied computer program and system that performs a method, defined by claims 1 and 8 respectively.

Second, the format of claiming a computer-readable medium with instructions to perform a method, or a computer programmed to perform the method, was approved in *In re Beauregard*, 35 USPQ2d 1383 (Fed. Cir. 1995). The primary difference between the *Beauregard* claims and claims 7, and 10-11 is that these claims depend from a base claim that is a process claim. This format may raise an initial concern because the preamble of the dependent claim differs from that of the base claim. However, dependent claims with preambles that differ from their base claim are not objectionable solely for that reason. The Board of Patent Appeals and Interferences expressed this holding in *Ex parte Adrianus P.M.M. Moelands*, 3 USPQ2d 1474 (PTO Board of Pat App and Int 1987). In *Moelands*, the Board upheld as appropriate the following dependent claim to a data transmission system:

11. A data transmission system comprising:  
at least two of the data transmission stations of claim 10;

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*a clock bus interconnecting the clock terminals of the stations; and  
means which maintain the clock bus at the second voltage level in the absence  
of forcing by the stations.*

Although the preamble in *Moelands'* claim 11 to a "data transmission system" is different than the preamble in claim 10 to a "data transmission station", the Board held that this dependent claim format satisfies the statutory requirements of both the second and fourth paragraphs of 35 U.S.C. §112.

Third, a claim having language similar to claims 7, and 10-11 which recites a computer readable medium encoded with a computer program is statutory subject matter and is treated as a product claim. MPEP §2106(IV)(B)(1)(a). Claim 7 recites: "A computer system having a processor, a memory and an operating environment, the computer system operable to perform the method of claim 1." Similar language appears in claims 10 and 11, which depend from claim 8. Claim 10 recites: "A computer readable medium having computer executable instructions for performing the method of claim 8." Again, similar language appears in claim 11, which depends from claim 8. Claim 11 recites: "A computer system having a processor, a memory and an operating environment, the computer system operable to perform the method of claim 8."

Fourth, a dependent claim is not per se improper merely because it is drawn to different statutory class than its corresponding base claim (i.e. an independent method claim with a dependent apparatus claim). MPEP §608.01(n)(III); MPEP §806.05(e). Claims 7, and 10-11 are in the statutory class of manufacture (or "product") claims, and depend from independent method claims 1 and 8.

Fifth, dependent claims that cross statutory classes are not per se objectionable. A claim in a format of "a computer readable media . . . for performing the method of claim X" is analogous to a product-by-process claim, which relates to more than one statutory class of invention (namely, a process and an article of manufacture). Product-by-process claims cross statutory claim classes but are not objectionable merely because they do. MPEP 2173.05(p). Claims 7, and 10-11 are similar to a product-by-process claim in that they define an embodied computer program that is executable on a computer to perform the methods set forth in claims 1 and 8, respectively. The methods are

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physically embodied in a computer program encoded on one or more computer-readable media and computer systems. Claims 7, and 10-11 are proper in their construction in that they reference and are dependent from claims 1 and 8, and define the product as having embodied thereon the methods in claims 1 and 8. Moreover, the metes and bounds of claims 7, and 10-11 are clearly set forth in the methods of claims 1 and 8, from which claims 7, and 10-11 respectively depend.

Sixth, this type of dependent- *Beauregard* claim format is ubiquitous, and widely appears in issued patents. In fact, a search of the USPTO database at <http://patft.uspto.gov/netahtml/search-bool.html> using "for performing the method of" (in quotations) as a query term for the "Claim(s)" field, returns 2,041 results as of Nov. 5, 2004. Arbitrarily picking the first patent (which happens to be U.S. No. 6,813,762), one notes claim 17 and its format: "17. A **semiconductor device** capable of performing the **method of claim 1**" Emphasis added.

Claim language very similar to claims 7, and 10-11 is common in this particular field of patents. Illustratively, similar claim language appears in the claims of U.S. Patent Nos. 6,810,291; 6,809,729; 6,808,248; 6,807,636; 6,807,548 and 6,807,546. For example, claim 19 of U.S. Patent No. 6,807,548 recites "A computer-readable medium having computer-executable instructions **for performing the method of claim 1**" emphasis added.

Accordingly, claims 7, and 10-11 are in condition for allowance because the claims are in proper dependent form. Applicants respectfully request the objection to claims 7, and 10-11 be withdrawn.

#### **Rejections Based on 35 U.S.C. § 102(b)**

In the Office Action, claims 1-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application No. 6,144,388 to Bornstein. ("*Bornstein*"). The foregoing rejections are respectfully traversed.

Independent claim 1 has been amended to include the feature of "*based on said selection of said first component image, receiving a selection of a second component image, said second component image depicting a second component.*" Independent claim 8 has been amended to include the features of "selecting at least one of said variety of component images" and "consulting a

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second data table to determine the coordinates on an (X,Y) axis of each *selected* component image that comprises the configured product image." Independent claim 12 has been amended to include the features of selecting "at least one of said plurality of component images" and positioning "said *selected* component images on a coordinate system." Independent claim 14 has been amended to include the features of "selecting at least one of said one or more component images" and "positioning the *selected* component images at their determined coordinates." Independent claim 18 has been amended to include the features of an implementor table having component entries "wherein one or more of said component entries are selected to make up said configured product" and a coordinate table having coordinate entries for the selected component images. Finally, independent claim 19 has been amended to include the feature of "*based on said selection of said first component image*, receiving a selection of said second component image, said second component image depicting a second component."

Applicants respectfully submit that *Bornstein* does not teach or suggest the selection of a second component image based on a selection of first component image. Rather, *Bornstein* teaches selecting an article of clothing to be displayed on a picture of a person. *Bornstein*, Col. 2, ln. 53-67; Col. 3, ll. 1-3; Col. 18, ll. 1-13. *Bornstein* teaches that a user may select an article of clothing to be displayed on a picture of the user. *Bornstein*, Col. 18, ll. 10-15. Prior to selection, the 3-dimensional article of clothing is deconstructed into component images for display on a 2-dimensional surface (i.e. a picture of a person). This deconstruction is not for purposes of selecting specific features of the article of clothing, but to map a 3-dimensional shape to a 2-dimensional surface. *Bornstein*, Col. 18, ll. 40-53; Col. 4, ll. 4-14. *Bornstein* does not teach or suggest the feature of selecting a first component (i.e. a picture of a person) and based on the selection of the first component, selecting a second component (i.e. the article of clothing). Thus, *Bornstein* does not teach or suggest the features of amended independent claims 1, 8, 12, 14, 18 and 19.

Accordingly, independent claims 1, 8, 12, 14, 18 and 19 are in condition for allowance. Furthermore, dependent claims 2-7 depend from independent claim 1, and are consequently in condition for allowance because they include each feature of claim 1. Dependent claims 9-11 depend from independent claim 8, and are in condition for allowance because they include each feature of claim 8. Dependent claim 13 depends from independent claim 12, and is consequently in condition

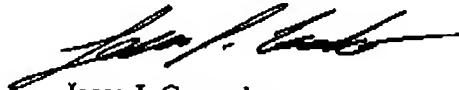
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for allowance because it includes each feature of claim 12. Dependent claims 15-16 depend from independent claim 14 and are consequently in condition for allowance because they include each feature of claim 14. Finally, dependent claims 20-24 depend from independent claim 19, and are consequently in condition for allowance because they include each feature of claim 19.

### Conclusion

*Bornstein* does not teach or suggest the claimed invention. For the reasons stated above, claims 1-24 are in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and a Notice of Allowance be issued in this case. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The commissioner is hereby authorized to charge any additional amount required, or credit any over payment, to deposit account No. 21-0765.

Respectfully submitted,



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